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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,574	04/01/2004	Shao Xiang Lu	LOREAL 3.0-038/OA 04156	1233
530 LERNER, DA	7590 12/11/2007 VID, LITTENBERG,		EXAMINER	
KRUMHOLZ & MENTLIK			SOROUSH, ALI	
600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

•		Application No.	Applicant(s)			
		10/816,574	LU, SHAO XIANG			
	Office Action Summary	Examiner	Art Unit			
		Ali Soroush	1616			
	The MAILING DATE of this communication ap	pears on the cover sheet v	vith the correspondence address			
Period fo			MANTHEON OR THIRTY (20) DAYS			
WHIC - Exte after - If NO - Failu Any	ORTENED STATUTORY PERIOD FOR REPL CHEVER IS LONGER, FROM THE MAILING Insions of time may be available under the provisions of 37 CFR 1. SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory period are to reply within the set or extended period for reply will, by staturely received by the Office later than three months after the mailined patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUN 136(a). In no event, however, may a I will apply and will expire SIX (6) MC	IICATION.  a reply be timely filed  ONTHS from the mailing date of this communication.  ABANDONED (35 U.S.C. § 133).			
Status						
1)⊠	Responsive to communication(s) filed on 09 I	<u>November 2007</u> .				
2a) <u></u> ☐	This action is <b>FINAL</b> . 2b)⊠ This action is non-final.					
3)						
	closed in accordance with the practice under	Ex parte Quayle, 1935 C.	D. 11, 453 O.G. 213.			
Disposit	ion of Claims					
4)⊠	Claim(s) 1-64 is/are pending in the application	n.				
•	4a) Of the above claim(s) <u>5,7-11,13,14,16-19,30,32,33 and 36-38</u> is/are withdrawn from consideration.					
	Claim(s) is/are allowed.					
_	Claim(s) <u>1-4,6,12,15,20-29,31,34,35 and 39-</u>	<u>64</u> is/are rejected.				
7)[		or election requirement				
8)[]	Claim(s) are subject to restriction and	of election requirements				
Applica	tion Papers					
9)[	The specification is objected to by the Examir	ner.				
10)	The drawing(s) filed on is/are: a) ac	ccepted or b) objected t	o by the Examiner.			
	Applicant may not request that any objection to th	e drawing(s) be held in abey	ance. See 37 CFR 1.85(a).			
	Replacement drawing sheet(s) including the correlation is objected to by the I	ection is required if the drawii Examiner, Note the attach	led Office Action or form PTO-152.			
11)	The oath or declaration is objected to by the t	Examiner. Note the attach	ed Chief Action of terms 1 2			
•	under 35 U.S.C. § 119					
12)	Acknowledgment is made of a claim for foreig	gn priority under 35 U.S.C	. § 119(a)-(d) or (f).			
а	)					
	1. Certified copies of the priority docume	nts have been received.	Application No.			
	2. Certified copies of the priority docume	nts have been received in	on received in this National Stage			
	3. Copies of the certified copies of the prapplication from the International Bure	lority documents have bee	SITTECEIVED IT THIS MALIONAL CLOSE			
*	See the attached detailed Office action for a li		ot received.			
	See the attached detailed Office detail for a m					
Attachme		" <b>–</b>	Summany (PTO 412)			
1) No	tice of References Cited (PTO-892) tice of Draftsperson's Patent Drawing Review (PTO-948)	Paper N	w Summary (PTO-413) No(s)/Mail Date			
3) 🔀 Info	prince of Dratsperson's Patent Drawing Nevew (110 010) prince of Dratsperson's Patent Drawing Nevew (110 010) per No(s)/Mail Date	5) Notice 6 6) Other:	of Informal Patent Application 			

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#### **DETAILED ACTION**

## Acknowledgement of Receipt

Applicant's response filed on 11/09/2007 to the Office Action mailed on 10/03/2007 is acknowledged.

#### Election/Restrictions

Applicant's election with traverse of styrene-ethylenebutylene-styrene as the gelled block polymer, unfunctionalized silicone elastomer core as the silicone elastomer core, and dimethicone as a swelling agent is acknowledged. Applicant argues that the requirement for election of species is not proper because it does not pose a serious burden on the examiner. Applicant argues that their assertion is supported by the fact that examiner has not shown that the individual species of the genus has separate classification or would require a different field of search. Applicant's arguments have been fully considered but not found to be persuasive. The compounds encompassed by the genus gelled block polymer have a variety of different subunits and a variety of different number of blocks. Therefore, the genus encompasses polymers having different structures and therefore would be classified separately. The compounds encompassed by the genus silicone elastomer core can have a variety of different functional groups (or no functional group) and therefore would be classified separately. The compounds encompassed by the genus swelling agent can encompass any known compound that causes the silicone resin to change conformation. As there are many compounds known to perform this action each compound also would be classified

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separately. For the foregoing reasons the requirement for species election is deemed proper and made Final.

#### Status of the Claims

Claims 5, 7-11, 13, 14, 16-19, 30, 32, 33, and 36-38 are withdrawn as being drawn to non-elected subject matter. Therefore, claims 1-4, 6, 12, 15, 20-29, 31, 34, 35, and 39-64 are pending examination for patentability.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Applicant Claims
- 2. Determining the scope and contents of the prior art.
- Ascertaining the differences between the prior art and the claims at issue;
   and resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 1. Claims 1-4, 6, 12, 15, 20-29, 31, 34, 35 and 39-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrison (International Application Published Under the PCT WO 02/41854 A2, Published 05/30/2002) in view of Kashihara et al. (International Application Published Under the PCT WO 02/092047, Published 11/21/2002).

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# **Applicant Claims**

Applicant claims a cosmetic composition comprising a gelled block copolymer and a silicone elastomer powder. Applicant further claims a method for care, make-up or treatment of keratin material.

# Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Morrison teaches a water resistant anhydrous cosmetic composition comprising at least one linear dimethicone, at least one block copolymer film former chosen from tri-block film formers, multi-block film formers and radial copolymer film formers. (See title and abstract). The at least one block copolymer film former of the present invention is chosen from the class of Kraton rubber or from similar gelling agents. (See page 4, Lines 24-26). The most common structure for the Kraton triblock copolymer is the linear A-B-A block type such as styrene-ethylenebutylene-styrene. (See page 5, Lines 5-8). "The at least one block copolymer film former may for example be formulated by dissolving the block polymer in a hydrocarbon solvent. Hydrocarbons useful in the practice of this invention, in one embodiment may be chosen from mineral oils, mineral solvents, mineral spirits, petroleum, waxes, synthetic hydrocarbons, animal oils, vegetable oils, and mixtures of various hydrocarbons. In one embodiment, the at least one block copolymer film former is formulated by dissolving a block copolymer in isododecane or a light parrafinic solvent." (See page 5, Lines 21-28). The composition may further comprise a powder material including any cosmetic powder, pigments including treated pigments, additional film formers, sunscreens, wax, etc. (See page 8,

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Lines 5-10, 14-21, 28 and page 10, Lines 1-9). The at least one block copolymer film former ranges from 1 to 30% by weight of the composition. (See page 6, Lines 22-23). The at least one powder material ranges from 0.1 to 50% by weight of the composition. (See page 8, Lines 12-13). The composition of the invention can be chosen from molded and poured cosmetics, cosmetic sticks, and transfer resistant powder. (See page 3, Lines 9-12). Morrison also teaches the application to the keratinous substance of the cosmetic composition. (See page 18, claim 27). The composition can be applied to the skin such as by blush, skin protectant stick, sunscreen stick and to the lips such as by lipstick. (See page 3, Lines 12-19).

# Ascertainment of the Difference Between Scope the Prior Art and the Claims (MPEP §2141.012)

Morrison lacks a teaching of a composition comprising silicone elastomer powder as the cosmetic powder. This deficiency is cured by the teachings of Kashihara et al.

Kashihara et al. teaches a cosmetic composition comprising silicone elastomer powder, water soluble polymer, water soluble humectant, a nonvolatile silicone compound, and an aqueous carrier. (See title and abstract). Particularly, useful herein as solid silicone powders are fine particles of a silicone rubber of which the particles have a composite structure that consists of a spherical or globular particle of a cured silicone rubber and coating layer of the polyorganosilsesquioxane resin. (See page 4, Lines 11-19). Commercially available solid silicone elastomer powders highly useful herein include vinyl dimethicone/methicone silsesquioxane crosspolymer. (See page 5,

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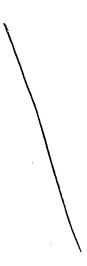
Lines 31-32). The silicone eleastomer provides for improved coverage of wrinkles, fine lines, and pores while providing good feel to the skin. (See page 1, Lines 9-11).

# Finding of Prima Facie Obviousness Rational and Motivation (MPEP §2142-2143)

It would have been obvious to one of ordinary skill in the art to combine the teachings of Morrison with Kashihara et al. One would have been motivated to do so because Morrison teaches that the anhydrous cosmetic composition can comprise any known cosmetic powder. Kashihara et al. teaches that the silicone elastomer powder provides for improved coverage of wrinkles, fine lines and pores. Therefore, it would have been obvious to one of ordinary skill in the art to combine Kashihara et al. with Morrison to improve the cosmetic of Morrison. With regard to the dimethicone being a swelling agent, this use is not considered a further limitation of the claim because the claim recites all the components of the composition. The intended use of the dimethicone is not given patentable weight. With regard to the block polymer having a hard segment concentration of 15 to 30%, glass transition temperature of at least 60C, and soft segment glass transition temperature of no higher than room temperature are implicit to the tri-block copolymer styrene-ethylenebutylene-styrene. With regard to the ratio of the silicone elastomer powder to gelled block polymer, the instantly claimed ratios would have been obvious to one of ordinary skill in the art. It would have been within the skill of an artisan to adjust the concentrations of the cosmetic powder and gelled block polymer through routine experimentation to arrive at the instantly claimed

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ratios. For the foregoing reasons the instant invention would have been obvious to one of ordinary skill in the art at the time of the instant invention.



#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number For the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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Ali Soroush Patent Examiner Art Unit: 1616 SASIHA QAZI, PH.D PRIMARY EXAMINER

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